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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/078,975

02/19/2002

Petrus Henricus Cornelius Bentvelsen

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05/24/2010

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

TRUONG, THANHNGA B

ART UNIT

PAPER NUMBER

2438

MAIL DATE

DELIVERY MODE

05/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/078,975	Applicant(s) BENTVELSEN, PETRUS HENRICUS CORNELIUS	
	Examiner THANHNGA B. TRUONG	Art Unit 2438	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 16-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7 and 16-21 is/are allowed.
- 6) ☒ Claim(s) 8-10 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the communication filed on February 19, 2010. Claims 2-10, 16-26 are pending. Claims 1 and 11-15 are cancelled by the applicant. At this time, claims 8, 10, and 24 are still rejected.

Response to Arguments

2. Applicant's arguments filed February 19, 2010, with respect to the rejection(s) of claim(s) 2-10, 16-26 under 35 USC 103 have been fully considered and are persuasive.

Applicant's arguments filed February 25, 2010, with respect to the rejection(s) of claim(s) 8-10 and 22-26 under 35 USC 101 have been fully considered but they are not persuasive.

Applicant has tried to amend claim 8 to overcome the 35 USC 101 rejection. However, the newly amended limitation still fails to make claim 8 statutory. Although applicant has claimed an apparatus for embedding a secondary signal of a secondary channel in the bitstream of a primary signal of a primary channel, the apparatus appears to be just another medium to embed and/or carry signal. Thus, the recited "apparatus" is not a "process," a "machine," a "manufacture" or a "composition of matter," as defined in 35 U.S.C. 101. Accordingly, claim 8 fails to recite statutory subject matter under 35 U.S.C. 101. Furthermore, in response to applicant's arguments, the recitation "an apparatus" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As to dependent claims 9-10 and 22-26, they are rejected under 35 U.S.C. § 101 for depending upon the non-statutory subject matter recited by independent claim 8.

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For the above reason, the rejection under 35 USC 101 is still maintained for claims 8-10, and 22-26.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 8-10, and 22-26 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to independent claim 8, Although applicant has claimed an apparatus for embedding a secondary signal of a secondary channel in the bitstream of a primary signal of a primary channel, the apparatus appears to be just another medium to embed and/or carry signal. Thus, the recited “apparatus” is not a “process,” a “machine,” a “manufacture” or a “composition of matter,” as defined in 35 U.S.C. 101. Accordingly, claim 8 fails to recite statutory subject matter under 35 U.S.C. 101. Furthermore, in response to applicant's arguments, the recitation “an apparatus” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As to dependent claims 9-10 and 22-26, they are rejected under 35 U.S.C. § 101 for depending upon the non-statutory subject matter recited by independent claim 8.

Allowable Subject Matter

5. Claims 2-7 and 16-21 allowed.

Conclusion

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6. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached at 571-272-3787. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/

Primary Examiner, Art Unit 2438

TBT

May 23, 2010

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